

## **REMARKS**

### **Summary of the Final Office Action**

Claims 17-18 stand withdrawn from consideration as allegedly being directed to a non-elected invention.

Claims 1-3, 11, and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sasaki Takeshi (JP Publication 2003-212425) ("*Sasaki*").

Claims 4-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of Kunzmann (U.S. Patent 4,537,545) ("*Kunzmann*").

Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of Okumura (U.S. Patent 6,089,558) ("*Okumura*").

Claims 12-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of Yamada (U.S. Patent 5,762,328) ("*Yamada*").

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of Schluckebier et al. (U.S. Patent 3,269,720) ("*Schluckebier*").

### **Summary of the Response to the Final Office Action**

Claim 1 is amended. Claim 2 is canceled. Applicants traverse the finality of the Office Action. Applicants traverse the withdrawal of claims 17-18. Claims 1 and 3-18 are pending with claims 1 and 3-16 under consideration.

### **The Finality of the Office Action**

The Office Action has been made final. Applicants traverse the finality of the Office Action for at least the following reasons. MPEP § 706.07(a) prohibits the making of an Office Action final if the Office Action "introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." In the Office Action dated May 11, 2009, claim 10 was rejected as being unpatentable over *Sasaki* in view of Coombs et al. (U.S. Patent 6,330,999) ("*Coombs*"). In the most recent Office Action, claim 10 stands rejected as being unpatentable over *Sasaki* in view of *Okumura*. Claim 10 was not amended after the May 11, 2009 Office Action, and although claim 1 was amended, *Okumura* is not relied upon to address the new

feature of claim 1. Further, no Information Disclosure Statement has been filed after the May 11, 2009 Office Action. Thus, the Final Office Action has introduced a new ground of rejection not necessitated by an amendment or Information Disclosure Statement. Accordingly, Applicants request that the finality of the Office Action be withdrawn.

**The Withdrawal of Claims 17-18**

The Final Office Action alleges that the invention of claims 1-16 is related to the invention of claims 17-18. Further, the Final Office Action alleges that these inventions are mutually exclusive. Accordingly, the Final Office Action has withdrawn claims 17-18 from further consideration. Applicants respectfully traverse the withdrawal of claims 17-18 for at least the following reasons. MPEP § 806.05 states that inventions are considered mutually exclusive “if a first invention would not infringe a second invention, and the second invention would not infringe the first invention.” Applicants submit that the Final Office Action does not apply this standard. Specifically, the Final Office Action has failed to show that the invention of claims 1-16 would not infringe the claims of 17-18 and vice versa. Accordingly, Applicants respectfully request that claims 17-18 be considered.

**The Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1-3, 11, and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Sasaki*. Claims 4-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of *Kunzmann*. Claim 10 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of *Okumura*. Claims 12-13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of *Yamada*. Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Sasaki* in view of *Schluckebier*. Applicants respectfully traverse the rejections for at least the following reasons.

Claim 1

First, with respect to independent claim 1, as amended, Applicants submit that *Sasaki* fails to disclose the feature “a binding piece that simultaneously interlocks with the plurality of punch holes.” Instead, the tape is *Sasaki* is inserted through each of the holes, successively, at different times. See, e.g., Drawing 8 of *Sasaki*.

Second, also with respect to independent claim 1, as amended, Applicants submit that *Sasaki* fails to disclose a sheet forward end position regulating plate as claimed. This feature appeared in original dependent claim 2. The Final Office Action alleges that movable base 110 is a sheet forward end position regulating plate as claimed. Applicants respectfully disagree for at least the following reasons. Movable base 110 does not align the forward end portions of the sheets of paper. This is clear from Drawing 6 of *Sasaki*. At most, movable base 110 is used in the application of binding tape. See paragraphs [0011]-[0012] of the machine translation of *Sasaki*. The only element in *Sasaki* that can reasonably correspond to the claimed “sheet forward end position regulating plate” is the member 42d shown in Fig. 7 of *Sasaki*. However, the member 42d is unmovable so that the member 42d cannot correspond to the “sheet forward end position regulating plate” which is “capable of being retracted.”

Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn. Further, Applicants submit that claims 3-15 are allowable at least because of their respective dependencies from independent claim 1 and the reasons set forth above.

Claim 16

With respect to independent claim 16, Applicants submit that *Sasaki* fails to disclose a sheet forward end position regulating plate as claimed. The Final Office Action alleges that movable base 110 is a sheet forward end position regulating plate as claimed. Applicants respectfully disagree for at least the following reasons. Movable base 110 does not align the forward end portions of the sheets of paper. This is clear from Drawing 6 of *Sasaki*. At most, movable base 110 is used in the application of binding tape. See paragraphs [0011]-[0012] of the machine translation of *Sasaki*. The only element in *Sasaki* that can reasonably correspond

to the claimed "sheet forward end position regulating plate" is the member 42d shown in Fig. 7 of *Sasaki*. However, the member 42d is unmovable so that the member 42d cannot correspond to the "sheet forward end position regulating plate" which is "capable of being retracted." Accordingly, Applicants respectfully request that the rejection of claim 16 be withdrawn.

### **CONCLUSION**

In view of the foregoing, Applicants respectfully request entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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